

REMARKS

Status of the Claims

Claims 1-29 and 31 are now pending in the present application. Claims 2, 24, 26, and 28 have been amended to more clearly to define the invention. Claim 30 was previously cancelled.

Claims Rejected under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 1-27, 29, and 31 under 35 USC § 103(a) as being obvious over Williams et al. (U.S. Patent No. 6,075,971) in view of Mankovitz et al. (U.S. Patent No. 5,523,794), and further in view of Small (U.S. Patent No. 5,808,689) and Terrill et al. (U.S. Patent No. 6,052,755). The Examiner asserts that Williams discloses a setup mode which enables users to select coupon categories they wish to receive; that Mankovitz discloses a portable coupon including keys, memory, a controller and a display; that Small discloses encoding and decoding data using the horizontal overscan portion of a video signal; and that Terrill discloses that RAM and ROM can be used interchangeably. The Examiner appears to conclude that an artisan of ordinary skill would have been led to combine and modify the references to achieve an equivalent invention in order to provide a more versatile system and method for distributing electronic coupons. Applicant respectfully disagrees for the following reasons.

Applicant's independent Claims 1, 13, 24, 27, 29, and 31 each share the common element (recited either as a step or as a function implemented by a processor) of enabling a user to manipulate a control key to enter a setup mode. In the setup mode, a menu of coupon categories is presented to the user, and the user is enabled to select one or more coupon category to which received coupon will be allocated. Any received coupon data is compared to the selected coupon categories, and coupons matching any selected coupon categories are stored.

In contrast, Williams discloses preference profiles that can be used to determine if a coupon should be sent to a specific user. While the preference profiles disclosed by Williams can be used to target coupons to specific users, the preference profiles disclosed by Williams function in a distinguishably different manner. Williams discloses:

Preferences may include, but are not limited to, the following: whether a user enjoys sports and what types of sports he or she enjoys, whether a user enjoys outdoor activities and what type of activities he or she enjoys, what type of television programming the user enjoys, etc. In addition the geographical location, native language, annual salary and/or profession or occupation of the user may be used to determine preferences. The types of foods enjoyed by the

1 user could also be used in determining a preference profile for users. Of
2 course, an exhaustive list is not provided and many more types and
3 combinations of preferences could be used to build preference profiles
(column 6, lines 13-24 of Williams).

4 Building of preference profiles for users allows server 320 to deliver coupons
5 to specific users that *have an observed or disclosed preference for a*
6 *particular service, product or activity*. Coupons may also be delivered to users
7 whose preferences include services, products or activities that are related to the
8 service, product or activity that is the subject of a particular coupon, etc.
9 Alternatively, a coupon may be provided as an attempt to induce a user to try a
new service, product or activity (column 6, lines 25-33 of Williams, emphasis
added).

10 It is important to note that completing a preference profile is not equivalent to selecting
11 coupon categories from a menu of coupon categories. While a preference profile certainly can be
12 employed to filter or target coupons, merely because a person has an interest in a certain activity or
13 topic does not mean that the person *wants* to receive coupons related to that interest. Essentially,
14 Williams describes a system that attempts to determine what a user likes (i.e. the user's preference
15 profile), determining which coupons relate to those likes, then sending all those related coupons to a
16 user. However, when presented with a list of menu categories, the same user might only select
17 grocery coupons from the menu of coupon categories, because regardless of that individual's interests
18 and likes, he or she may only *want* coupons related to groceries. The preference profile taught by
19 Williams relates to general subjects of interest to a user, which are likely to be very different than the
20 menu of coupon categories employed in the present invention. Even if a preference profile is 100
21 percent accurate, use of such a profile to select coupons is likely to result in a user receiving coupons
22 they have no desire or interest in redeeming, because the user's interest in a topic or activity is
23 frequently not equivalent to a desire to receive a coupon for use in purchasing a product in a specific
24 category.

25 When preference profiles are used to match coupons as taught by Williams, a third party is
26 determining both what coupon categories relate to specific preferences, and is assuming that the
27 existence of a preference means coupons related to that preference should be provided to the user. In
28 the present invention, the end user has complete control over the categories of coupons that will be
29 downloaded for redemption by the user. The end user (i.e., the user of the electronic coupon) can
30 determine that he or she does not want to receive coupons in certain categories, even if those

1 categories related to some personal preference of the user (e.g., an interest in sports). Thus, providing
2 coupons based on preference profiles as taught by Williams can be overly broad as compared to the
3 menu of coupon categories employed in the present invention.

4 The end user can further determine that he or she wants to receive coupons in certain
5 categories that have no correlation with the user's personal preferences. For example, a particular
6 user may have no interest in literature (so that when filling out a preference profile, that lack of
7 interest in literature would be recorded), yet there may be a time when that user is looking for a gift
8 for a person who has an interest in literature. Such a user could then access the setup mode of the
9 electronic coupon, and select books from the menu of coupon categories so that the user becomes
10 aware of coupons offered to purchase books from bookstores. Once the user has purchased the gift,
11 the user can then once again access the setup mode, and deselect books. The preference profiles
12 described by Williams refer to long term general interests (native language, occupation, hobbies such
13 as sports and outdoor activities), and do not relate to transient interests, such as noted in the previous
14 example. In the present invention, each user specifies the categories of coupons that he or she wants
15 to receive based on any desired combination of long term and transient interests and needs. Thus the
16 preference profiles taught by Williams can also be overly narrow as compared to the menu of coupon
17 categories employed in the present invention, as there are times a user may wish to receive coupons
18 unrelated to their own preferences as they defined them when registering for Williams' entertainment
19 service. A preference profile that is 100 percent accurate is likely to result in users being unable to
20 receive coupons they desire for goods and services not related to their personal preferences.

21 It should also be noted that Williams teaches preference profiles which can be generated by
22 tracking a user's use of an entertainment system and that a preference profile can be completed by the
23 user when registering with an entertainment service. Thus, Williams' preference profiles cannot be
24 readily changed by the user from time-to-time, to reflect changing or transient interests, such as
25 looking for a gift for someone with different interests (hence a different preference profile). Further,
26 Williams does not teach or suggest that a user is enabled to delete an interest (i.e., to no longer
27 receive coupons of a specific type). There is no teaching or suggestion in Williams of using a key on
28 an electronic coupon to access a setup mode for this purpose, as claimed by applicant.

29 Even if the references are combined in the manner suggested by the Examiner, the result
30 achieved is not equivalent to the invention defined in independent Claims 1, 13, 24, 27, 29, and 31,

1 because use of the preference profiles disclosed by Williams is not equivalent to a setup mode
2 displaying a menu of coupon categories. Because dependent claims are patentable for at least the
3 same reasons as the claims from which they depend, each claim depending on independent
4 Claims 1, 13, 24, 27, and 29 is also distinguishable over the cited art, for the same reasons.
5 Accordingly, the rejections of Claims 1-25, 27, 29, and 31 under 35 U.S.C § 103 as being obvious
6 over Williams in view of Mankovitz, Small, and Terrill should be withdrawn.

7 With respect to Claim 9 and Claim 26, each claim recites an electronic coupon including a
8 *mode key* that enables a user to toggle between a redeem mode *and* a storage mode. In rejecting
9 Claims 9 and 26, the Examiner asserts that the read and save keys disclosed by Mankovitz perform
10 equivalent functions. The Examiner appears to overlook that applicant has not recited save and read
11 keys, but instead, has recited a *mode key* that enables a user to select between a storage mode and a
12 redeem mode. The fact that Mankovitz has a read key and a save key associated with redeeming and
13 storage does not mean that Mankovitz teaches or suggests a mode key. The recited mode key is
14 distinguishable over a separate read key and a separate save key. To access the storage mode in the
15 present invention, a user presses the mode key, resulting in the display indicating whether the
16 electronic coupon is in the save mode or redeem mode. If the electronic coupon is not presently in
17 the desired mode, the mode key is activated again, until the desired mode is achieved. According to
18 Mankovitz, a save mode is achieved by pressing the save key, and a redeem mode is achieved by
19 pressing the read key. Applicant respectfully points out that this argument has been previously
20 presented to the Examiner, and the Examiner has not yet responded to the issue of a mode key being
21 distinguishable over save and read keys. While related, applicant's mode key clearly functions in a
22 different and non-obvious way, compared to Mankovitz's read and save keys, and there appears no
23 basis other than hindsight for modifying Mankovitz's key configuration to achieve applicant's mode
24 key. For this additional reason, the rejection of Claims 9 and 26 under 35 U.S.C § 103 as being
25 obvious over Williams in view of Mankovitz, Small, and Terrill should be withdrawn.

26 Turning now to the rejection of Claims 24-25, the Examiner has asserted that Mankovitz
27 discloses an electronic coupon including a VBI decoder, and concludes that it would have been
28 obvious to modify Mankovitz's VBI decoder in view of Small to achieve an electronic coupon
29 comprising a decoder configured to extract coupon data from the horizontal overscan portion of the
30 video signal. Claim 24 recites that the decoder is *part* of the electronic coupon. Regardless of

1 whether modifying Mankovitz in view of Small would have been obvious, the result would still be a
2 decoder implemented as a separate component – not as part of the electronic coupon. The Examiner
3 appears to assert that because Mankovitz discloses that the decoder/controller must communicate
4 with the electronic coupon via a wireless interface or a hardware connection, the combination
5 decoder/controller and electronic coupon is an electronic coupon with an integral decoder. Applicant
6 has amended the claims to clearly recite that the decoder and other element share a common housing.
7 Mankovitz does not teach or suggest this element, and there appears no basis other than hindsight for
8 modifying Mankovitz's electronic coupon to achieve the invention defined in Claim 24. It should be
9 noted that Claim 2 also recites an integrated decoder. For this additional reason, the rejection of
10 Claims 2, 24, and 25 (which depends from Claim 24 and are patentable for the same reasons) under
11 35 U.S.C § 103 as being obvious over Williams in view of Mankovitz, Small, and Terrill should be
12 withdrawn.

13 The Examiner has rejected Claim 28 based on the combination of Small and Mankovitz. As
14 with Claims 2 and 24 discussed above, Claim 28 recites a decoder integrated into the electronic
15 coupon. Claim 28 has also been amended to recite the common housing element noted above.
16 Accordingly, the rejection of Claim 28 under 35 U.S.C § 103 as being obvious over Mankovitz in
17 view of Small should be withdrawn.

18 Claims 19, 26, 29, and 31 each recite elements that define an invention distinguishable over
19 the art cited by the Examiner. Each such claim define a storage mode that is different from what is
20 disclosed in the cited art and not obvious in view of the prior art. Applicant has previously attempted
21 to make this distinction clear, however, it is not clear from the record that the Examiner has properly
22 considered this issue. Applicant respectfully requests that should the Examiner disagree with the
23 following discussion, the Examiner articulate the reasons for such disagreement, so that applicant will
24 better understand how to respond. Each of Claims 19, 26, 29, and 31 define an electronic coupon that
25 functions as a state machine. That is, the functions executed by the processor are based on specific
26 key selections made by a user. While some of the functions disclosed by Mankovitz are dictated by a
27 keystroke, other functions occur automatically, regardless of a key selection by the user. In
28 particular, the storage of coupon data is distinguishable.

29 In the electronic coupon disclosed by Mankovitz there are two memories; a first-in-first-out
30 (FIFO) buffer, and a protected memory. So long as the electronic coupon is coupled to the external

1 decoder/controller (via a wireless connection or a hardware connection), coupon data extracted from
2 a video signal are directed to the buffer. The user must affirmatively select first the read key to cause
3 a particular coupon to be displayed, and then the save key, to cause that particular buffer to be moved
4 from the buffer to the protected memory. If Mankovitz's electronic coupon was modified to include
5 a coupon filter functionality based on preference profiles as disclosed by Williams, the filtering
6 would logically apply to all of the coupons added to the buffer (note that Williams teaches filtering
7 all coupons, not just selected coupons). According to Williams, once the preference profile is
8 complete, the user is required to perform no action for such preference profile-based filtering to
9 occur. However, as recited in applicant's claims, the analysis of incoming coupons as compared to
10 user selected menu categories occurs only after the user has first actuated a mode key to select a
11 storage mode. If the user does not affirmatively select the storage mode via a keystroke, no coupons
12 are received, and no filtering/analysis of the coupons occurs.

13 Claim 19 recites the step of enabling the user to select a storage mode available in the
14 electronic coupon by manipulating a key on the electronic coupon, and the controller responding to
15 selection of the storage mode by analyzing the extracted coupon data. Clearly, until the user has
16 affirmatively selected the storage mode, the controller in the electronic coupon does not determine a
17 coupon category, store matching coupons, or reject non-matching coupons (see Claim 13, from which
18 Claim 19 depends). The disclosures of Mankovitz and Williams do not teach or suggest that the
19 filtering process is based on a user action.

20 Claim 26, as amended, recites enabling a user to manipulate said mode key to select a storage
21 mode such that only when the storage mode is selected, are coupons defined by the extracted coupon
22 data and received by the receiver, then stored in said memory. As discussed above, Mankovitz
23 clearly teaches that not only are some coupons stored when a save key is pressed, but all coupons are
24 stored in the FIFO buffer as they are received. Mankovitz does not teach or suggest only storing
25 coupons in an electronic coupon based on a user manipulation of a mode key.

26 Claim 29 recites actuating the mode key to selectively enter the storage mode, such that in
27 response to selection of the storage mode, the electronic coupon is enabled to automatically evaluate
28 any coupon data extracted from the horizontal overscan portion of a video signal to determine if such
29 coupon data correspond to a coupon category selected in the start up mode. Again, Williams does not
30 teach or suggest filtering based on a user selection of a storage mode. According to Williams,

1 filtering based on preference profiles occurs all the time, not only in response to a user manipulation
2 of a mode key to access a storage mode. There is no disclosure in Mankovitz, or any other cited art,
3 that suggests filtering occurs only in response to a user action, as opposed to automatically analyzing
4 each coupon as it is received.

5 Claim 31 similarly provides for responding to a user employing the mode key to select the
6 storage mode by automatically analyzing each coupon defined by coupon data extracted from a video
7 signal by the decoder and received by the electronic coupon, such that only coupons that correspond
8 to a coupon category selected by the user in the setup mode are automatically stored in the memory,
9 and each coupon that does not correspond to a coupon category selected by the user in the setup
10 mode is automatically discarded. Again, in the present invention as defined in Claim 31, filtering
11 occurs only after an affirmative action by the user in selecting the storage mode is made, and not
12 automatically.

13 The cited art discloses an electronic coupon that includes a functionality related to that of the
14 present claimed invention, but the processor configuration and specific steps employed in the present
15 invention achieve a clearly distinguishable result. There is no evidence that the cited art provides any
16 motivation for modifying the references as would be required to achieve an equivalent invention, or
17 that such modifications would solve a problem recognized by artisans of ordinary skill at the time of
18 the invention. For this additional reason, the rejection of Claims 19, 26, 29 and 31 as being obvious
19 in view of any combination of the cited art is not merited, and such claims should be allowed.

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In view of the preceding amendments and remarks, it will be apparent that all claims in this case define a novel and non-obvious invention, and that the application is in condition for allowance and should be passed to issue without delay. Should any further questions remain, the Examiner is asked to telephone applicant's attorney at the number listed below.

Respectfully submitted,

Michael C. King
Registration No. 44,832

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 13, 2003.

Date: November 13, 2003

Kathy Paul

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